

PATENT
70111.00028

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: BRIAN MARK SHUSTER

Serial No.: 09/837,071

Filed: April 18, 2001

Title: SYSTEM AND METHOD FOR
AGGREGATING INFORMATION OVER A
WIDE AREA NETWORK

Art Unit: 3622

Examiner: Donald Champagne

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

The appellant filed an Appeal Brief on October 31, 2007 in the above-identified application (the "Appeal Brief"), to which the Office provided an Examiner's Answer on January 18, 2008 (the "Answer").

Answer Fails To Address Key Arguments

The first portion of the Answer "[e]xcept for correcting a typographical error, is a verbatim copy of the final rejection mailed on 6 June 2007." Answer, p. 3:2-3. Being drafted in response to the Final Office Action, the Appeal Brief already addresses the arguments made in this copied portion, subject to the instant Reply. Beginning on page

6 under the heading “**(10) Response to Argument**”, the Answer responds to certain arguments made in the appeal brief. These arguments do not cure the fatal defects in the rejections under 35 § 102(b) and 35 § 103(a), addressed in turn below.

1. Rejections Under 35 U.S.C. § 102(b)

A. Claims 1 & 21

Claim Construction Error

The *prima facie* case of obviousness set forth in the Final Action and Answer rests on an erroneous claim construction. The error consists of making no distinction between the different claim terms “said plurality of remote information systems” and “said plurality of reception devices”:

The examiner sees no clear difference between the “remote information systems” and the “reception devices.” A PC operating a bulleting [sic] board could be both an RIS and a reception device, and would read on the claim.

Answer, p. 6 ¶ 12. By construing these terms to mean an identical thing, the Examiner destroys the coherence of these claims. Once this erroneous construction of claims 1 and 21 is corrected, the § 102(b) rejections of these claims must fail.

As used in claims 1 and 21, “said plurality of remote information systems” must be construed as distinct from “said plurality of reception devices.” Construing two different claim terms as having the same meaning would contravene an important canon of claim construction. Different claim terms ordinarily have different meanings if they are used in the same claim. *See Applied Med. Res. Corp. v. U.S. Surgical Corp.*,

448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006) ("[T]he use of two terms in a claim requires that they connote different meanings"); *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed Cir. 2000) ("In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connote different meanings."). This is because "claims are to be construed to 'preserve the patent's internal coherence.'" *Applied Med. Res. Corp.*, 448 F.3d at 1333 n. 3 (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996)). Indeed, the specification or other evidence "may require that two terms in a claim refer to different structures." *Id.*, citing *Philips v. AWH Corp.*, 415 F.3d 1303, 1312-19 (Fed. Cir. 2005). Claims 1 and 21 use both terms "remote information systems" and "reception devices." Accordingly, these two different terms must have different meanings in the same claim. As near as can be discerned from the Answer, the examiner has proposed only an identical meaning for both terms: any group of PCs operating a bulletin board. This is clearly erroneous.

The requirement for different meanings being clear, the specification should be consulted to determine what this meaning should be, and whether it compels construing the different terms as different structures. In issuing patents, the Patent and Trademark Office is to determine claim scope "in light of the specification as it would be interpreted by one of ordinary skill in the art." *Philips v. AWH Corp.* at 1316, quoting *In re Am. Acad. Of Sci. Tech. Cen.* 367 F.3d 1359, 1364 (Fed. Cir. 2004); see also M.P.E.P. § 2111. In the present application, the claim terms at issue are expressly defined as

different terms. The task is determining what these different claim terms mean in light of the specification, subject to the rule that they cannot mean the same thing, and without importing limitations from the specification.

Figure 1 of the present application reproduced below illustrates "a plurality of reception devices" (RD) and "a plurality of remote information systems" (RIS):

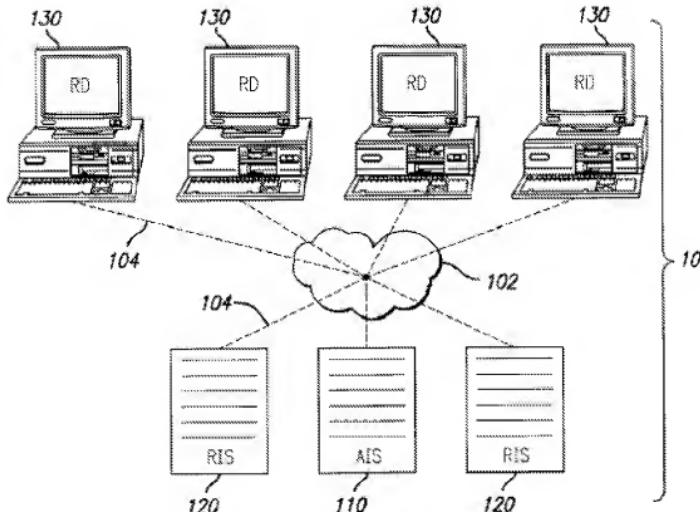


FIG. 1

The specification explains that:

In the preferred embodiment, an aggregated assembly 10 includes an aggregated information system 110, a plurality of remote information systems 120, and a plurality of reception devices 130 communicating through a wide area network 104, such as the Internet 102. It should be

appreciated that the reception devices 130 depicted in FIG. 1 include, but are not limited to, personal computers, set top boxes, televisions, personal digital assistances (PDAs), mobile phones, and all other physically and wirelessly connected reception devices generally known to those skilled in the art.

P. 5:28-6:6. The specification provides a more detailed depiction of a remote information system (120) in Figure 2, reproduced below:

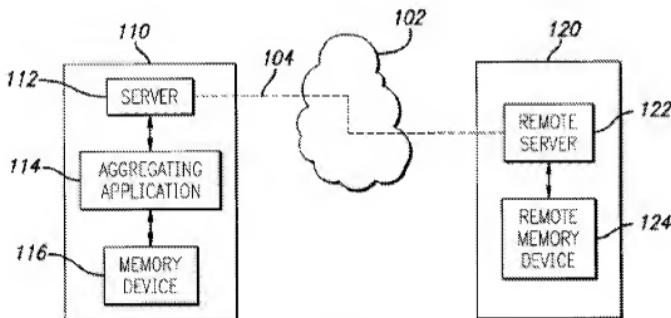


FIG. 2

The specification describes a remote information system (120) as follows:

Specifically, the aggregated information system 110 further includes a memory device 116, a server 112, and an aggregating application 114 adapted to aggregate information from the plurality of remote information systems 120. Each remote information system 120 further includes a remote memory device 124 and a remote server 122 adapted to communicate with the server 112 via a wide area network 104, such as the Internet 102. It should be appreciated that the memory devices 116, 124 depicted in FIG. 2 include, but are not limited to, RAM, cache memory, flash memory, magnetic disks, optical disks, removable disks, SCSI disks, IDE hard drives, tape drives, smart cards, and all other types of data storage devices (and combinations thereof, such as RAID

devices) generally known to those skilled in the art.

Thus, the specification shows and describes the remote information systems as including a server and a memory device. In comparison, reception devices include all “physically and wirelessly connected reception devices generally known to those skilled in the art.” P. 6:4-6. The specification thereby clearly assigns the labels “remote information system” and “reception device” to different classes of devices. These different classes are described with some evident overlap, for example, a personal computer could be configured to belong to either class.

Appellant does not argue, however, that these descriptive differences concerning device types must be imported into the claims. Instead, the examples illustrate that, read in light of the specification, claims 1 and 21 use the different labels to refer to distinct groups of devices. In fact, the specification exclusively describes systems in which the reception devices (130) and remote information systems (120) make up distinct groups, without any common members. See, e.g., Figs. 1, 2-4, 6. Therefore, the broadest reasonable construction of these terms must recognize that the “plurality of reception devices” requires a group of devices that is distinct from the “plurality of remote information systems.” By elementary rules of logic, no two groups containing plural members can be distinct unless one of the groups contains a member that is not contained in the other group. Conversely, if two groups have exactly the same members, they are indistinct. The two claimed pluralities must refer to distinct groups, because otherwise the groups would be the same, thereby violating the canon of claim

construction that "use of different terms connotes different meanings." Whether or not this distinctiveness requires that the respective pluralities of devices have no members in common, as the specification exclusively discloses, is not at issue. Hertz fails to disclose any plausibly distinct pluralities of devices reading on the claim terms, nor has the examiner provided any argument to this effect.

Novelty of Claims 1 and 21, Correctly Construed

The Answer correctly notes that Hertz discloses at col. 7:29-33 "*organizing articles into groups*" and, in a separate context at col. 56:43, "*organizing electronic mail*." Answer, p. 6:19-20. The Answer does not rebut appellant's showing that "[a]rticles" as disclosed by Herz does not read on 'original message data and response message data' as defined by claims 1 and 21." Answer, p.7:4-6; 7:26-28. Appeal Brief p. 8:6-7. The Answer depends instead the examiner's finding that "[e]lectronic mail does read on 'original message data and response message data'" Answer, p. 7:5-6. This bare proposition is not determinative of anticipation. Hertz fails to disclose any process performed on electronic mail that is the same as what is defined by claims 1 and 21, once it is recognized that the "plurality of reception devices" and the "plurality of remote information systems" must be construed to be distinct groups.

Claim 1 defines an aggregating application adapted to:

configure said original message data and said response message data from different ones of said plurality of remote information systems to be arranged together as aggregated message and response data relating to a topic.

Claim 21 similarly defines a method including:

configuring said original message data and said response message data from different ones of said plurality of remote information systems to be arranged together as aggregated message and response data relating to a topic.

Claim 1 further defines that the application is adapted to “retrieve said original message data and said response data **from said plurality of remote information systems**,” and to “provide said aggregated message and response data **to said plurality of reception devices**.”

For its part, claim 21 defines “retrieving said original message data and said response message data **from said plurality of remote information systems**.” Claim 21 also defines “providing said aggregated message and response data **to a plurality of reception devices**.”

In keeping with the canons of claim construction, the plurality of remote information systems must comprise a distinct group from the plurality of reception devices in both claims 1 and 21. Hertz does not disclose the combination of elements of claims 1 and 21 discussed above, because Hertz fails to disclose retrieving original and response message data from a plurality of remote information systems, aggregating said original and response message data to be arranged together as aggregated data, and providing the aggregated data to a plurality of reception devices **that must be distinct** from the plurality of remote information systems. Hertz merely discloses organizing electronic mail, as follows:

This method is especially useful for selecting which articles to read from electronic news groups and electronic bulletin boards, and can be used as part of a system for **screening and organizing electronic mail**.

Hertz, col. 56:40-43 (emphasis added). Hertz fails to disclose where the electronic mail that is organized is located, or to whom it pertains. However, it is self-evident that Hertz can only be referring to the user's own mail, that is, mail that is addressed to or authored and archived by the same user for whom it is screened and organized. Such is the operation of electronic mail; it is accessible only to the addressee or author. See, e.g., Hertz at col. 9:36-38. Hertz fails to disclose retrieving electronic mail from a plurality of systems, arranging it together as aggregate electronic mail data, and providing the aggregate electronic mail data to a plurality of devices **that are distinct** from the plurality of systems from which the electronic mail was received in the first place. This is not disclosed by Hertz, nor would it inherently occur when electronic mail is organized.

Nor does Hertz disclose any analogous action on bulletin board data. The Final Action and Answer cited Hertz at col. 73:24-32 as disclosing a bulletin board; that computer bulletin boards were known in the art is not disputed. However, here and elsewhere, Hertz fails to disclose:

configuring said original message data and said response message data from different ones of said plurality of remote information systems to be arranged together as aggregated message and response data relating to a topic

as defined by claim 21, and similarly by claim 1. As Hertz teaches, ""this method only serves to locate existing virtual communities." Col. 73:32-33. In other words, Hertz

discloses developing a target profile for "a cluster of documents posted on some bulletin board," for use in locating sites believed to be of interest to a user, but fails to disclose what is claimed.

B. Claims 4 & 23

The Answer states that "the examiner could not find a coherent argument here (Brief pp 10-13)." This, at least, explains why the examiner failed to response to the essential argument made, summarized as follows. First, it is improper to construe "said reception devices" (referring to the plurality of reception devices) as one and the same thing as the "plurality of reception devices." See above regarding the claim construction canon of assigning different meanings to different terms. Second, when those terms are given different meanings, claims 4 and 23 define an apparatus or method in which additional response message data and additional original message data received **directly from said reception devices** is aggregated with the original and response message data which, according to claims 1 and 21, respectively, is received **from the plurality of remote information systems**. Hertz fails to disclose this, so the Answer argues instead that there is no distinction between the claimed plurality of remote information systems and the reception devices.

C. Claims 5, 6, 24 and 25

The case of anticipation for claims 5, 6, 24 and 25 again rests on the erroneous position that there is no distinction between the claimed plurality of remote information

systems and the reception devices. So long as these claims are construed consistent with the canons of claim construction outlined above, the arguments in the Appeal Brief fully and effectively traverse the rejections under § 102(e). At this point, no more need be said by way of reply.

2. Rejections Under 35 U.S.C. § 103(a)

With respect to claims 8-15, 19, 20, 27-30 and 34, the Answer brushes aside the detailed showings in the Appeal Brief that these rejections "fail to consider all the words in these claims" by saying that "[i]t is true that the rejection does not repeat all the words of the subject claims, but that hardly proves the rejection is improper." Answer, p. 9:11-15. As such, the Answer attacks a "straw man" argument that "the rejection does not repeat all the words of the subject claim," which appellant never advanced. To the contrary, the Appeal Brief includes detailed arguments that the features of claims 8-15, 19, 20, 27-30 and 34 have not been shown to exist in the prior art, including the matter taken official notice of. Nor does the Answer attempt to explain in any substantive fashion why, based on taking official notice that email advertising and nominating were known in the art, it is not necessary to demonstrate that the detailed features of claims 8-15, 19, 20, 27-30 and 34 were also known. The Answer simply fails to respond to appellant's arguments.

Thus, the Answer and Final Action have not demonstrated that the combination of elements defined by claims 8-15, 19, 20, 27-30 and 34 were found in the prior art.

The entire sum of reasoning for rejecting claims 8-15, 19, 20, 27-30 and 34 consists of taking official notice that "email advertising and selection by nomination were common, at the time of the instant invention." Answer, p. 5:1-3. Such is not enough to demonstrate obviousness under of 35 U.S.C. § 103(a). Every one of claims 8-15, 19, 20, 27-30 and 34 defines more detailed elements than mere "email advertising" or "selection by nomination." These more detailed features are self-evident from inspection of the claims, and are enumerated in detail in the Appeal Brief.

If more general ideas made obvious all specific inventions with more detailed elements, there would scarcely be any need for examiners, nor could any invention be fairly called patentable. One could have denied the Wright Brothers a patent on their specific flying machine merely by showing that Lilienthal, or for that matter, Icarus, knew about the usefulness of wings. The objective question of obviousness, however, requires ascertaining the "differences between the prior art and the claims at issue." *KSR Intern. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007) *citing Graham v. John Deere Co. of Kansas City*, 86 S. Ct. 684 (1966). This cannot be accomplished without considering all the words in the claims, which neither the Final Action nor the Answer apparently admits any responsibility to do.

Neither is there any authority for ignoring specific claim limitations. The KSR decision did not change the law in that respect. On the contrary, KSR pertains to obviousness of claims that are based on a combination of elements acknowledged to be found in the prior art: "Neither § 103's enactment nor Graham's analysis disturbed the

Court's earlier instructions concerning the need for caution in granting a patent *based on the combination of elements found in the prior art.*" KSR, 127 S. Ct. at 1731 (emphasis added). There is no legal basis for ignoring express claim elements, and the rejections under § 103(a) should therefore be reversed.

3. Official Notice Was Timely and Properly Traversed

The Answer does not dispute that appellant timely argued that, regardless of whether or not advertising and nominating were known in the art, the more specific features set forth in claims 8-15, 19, 20, 27-30 and 34 have not been shown to have been known in the art, and therefore no *prima facie* case of obviousness has been made against these claims. Whether or not appellant timely traversed the taking of official notice that "email advertising and selection by nomination were common, at the time of the instant invention" is not pertinent to the traversals that appellant timely raised. The issue merely provides another convenient straw man for the examiner, the knocking down of which does nothing to bolster a fatally defective *prima facie* case.

Conclusion

Appellant respectfully requests the reversal of the rejection of currently pending claims 1-6, 8-25 and 27-36, and allowance of these claims forthwith, for the reasons set forth above and in the Appeal Brief.

Serial No. 09/837,071
March 18, 2008
Page 14

Respectfully submitted,

Date: March 18, 2008

/Jonathan Jaech/
Jonathan Jaech
Attorney for Applicant
Registration No. 41,091

CUSTOMER
NUMBER
58688
PATENT TRADEMARK OFFICE

Connolly Bove Lodge & Hutz LLP
333 South Grand Avenue
Suite 2300
Los Angeles, CA 90071
(213) 787-2500